

1 REMARKS

2 Status of the Claims

3 Claims 1-56 are now pending in the present application; Claims 57-61 having been previously
4 canceled. Claims 1, 13, 14, 21, 35, and 42 are amended to more particularly point out and claim the
5 subject matter considered novel by applicants in light of the cited art.

6 Claims Rejected Under 35 U.S.C. § 102(e)

7 In the Final Office Action dated August 25, 2005, the Examiner rejected Claims 1-3, 7, 10, 12-15,
8 19, 21, 22, 29, 31, 32, 35, 38, 40-43, 50, 52, and 53 under 35 U.S.C. § 102(e) as being anticipated by U.S.
9 Patent Application No. 2001/0010059 (Burman et al., which is hereinafter referred to as "Burman"). The
10 Examiner considered applicants' arguments and amendment filed on May 16, 2005, but was not
11 persuaded. Applicants respectfully request that the Examiner reconsider the claims in this application in
12 view of the above amendments to the claims and the following discussion.

13 In the interest of reducing the complexity of the issues for the Examiner to consider in this
14 response, the following discussion focuses on independent Claims 1, 13, 14, 21, 35, and 42, all as
15 amended. The patentability of each remaining dependent claim is not necessarily separately addressed in
16 detail. However, applicants' decision not to discuss the differences between the cited art and each
17 dependent claim should not be considered as an admission that applicants concur with the Examiner's
18 conclusion that these dependent claims are not patentable over the disclosure in the cited references.
19 Similarly, applicants' decision not to discuss differences between the prior art and every claim element, or
20 every comment made by the Examiner, should not be considered as an admission that applicants concur
21 with the Examiner's interpretation and assertions regarding those claims. Indeed, applicants believe that
22 all of the dependent claims patentably distinguish over the references cited. Moreover, a specific traverse
23 of the rejection of each dependent claim is not required, since dependent claims are patentable for at least
24 the same reasons as the independent claims from which the dependent claims ultimately depend.

25 Preliminary Remarks

26 The Examiner's response to applicants' arguments included the following comment: "If Applicant
27 wishes to preclude inclusion of machine instructions by reference, the Examiner recommends that the
28 claims be amended to require the distributed application data (Web Page) and machine instructions to be
29 located in a single file, or a similar recitation which limits the number of files that may be transmitted."
30 Applicants have amended Claims 1, 13, 14, and 21 in accord with the Examiner's suggestion as indicated

1 above. Support for the amendments to claims 1, 13, 14, and 21 are provided at least by page 8, lines 24-
2 28, page 17, lines 13-16 of applicants' specification. Additional support for the amendments to Claims 1,
3 13, 21, 35, and 42 are provided at least by page 19, lines 18-31, and page 20, Table 2, specifically, the
4 actions identified at times t6-t9 regarding the loading and operation of a monitoring function.

5 The Examiner rejected Claims 1, 13, 14, 21, 35, and 42 over Burman. As noted above, applicants
6 have amended Claim 1, paragraph (c), which now recites, "appending machine instructions that define a
7 performance monitoring function to the distributed application data that were requested and transmitted
8 over the network to the second site *as one data file*" (emphasis added). Burman does not disclose or
9 suggest "appending machine instructions that define a performance monitoring function to [] distributed
10 application data," which are then "transmitted over [a] network to [a] second site *as one data file*," as
11 recited by applicants amended Claim 1. Instead, Burman specifically requires that "[a] web page sent or
12 served to the user's browser during step 104 will include a link or reference to a rich media file, such as a
13 script (e.g., JavaScript, VBScript) or an IFRAME reference to be fetched by the user's browser during
14 step 106. (Burman, paragraph 47, lines 11 - 16.) Furthermore, Burman makes it clear that "upon receipt
15 by the user's browser of the desired web page served during step 104, the user's browser will send or
16 initiate a *fetch rich media request* during the step 106." (Emphasis added, Burman, paragraph 48, lines
17 1-4.) Clearly, Burman does not teach or even contemplate "appending machine instructions that define a
18 performance monitoring function to [] distributed application data," which are then "transmitted over [a]
19 network to [a] second site *as one data file*," as recited by applicants' amended Claim 1. For at least this
20 reason, Burman does not anticipate or render obvious the recitation of applicants' Claim 1. Additionally,
21 Claims 13, 14, and 21 have each been similarly amended to recite that machine instructions are appended
22 to distributed application data for transmission as one data file. Therefore, each of Claims 13, 14 and 21
23 are novel and nonobvious over Burman for at least the same reason as discussed above for Claim 1.

24 Furthermore, paragraph (d) of Claim 1 has been amended to recite that a performance metric is
25 determined "without using the performance monitoring function to request any distributed application
26 data from *any* site, *at least one performance metric being determined in connection with timing of events*
27 *occurring during the transmission of the distributed application data to the second site.*" (Emphasis
28 added.) This amendment thus clearly further distinguishes applicants Claim 1 over Burman, since "at
29 least one performance metric is determined in connection with timing of events occurring during the
30 transmission of the distributed application data to the second site," solely from the "distributed application

1 data that were requested and transmitted over the network to the second site as one data file." Table 2 in
2 applicants' specification details how the times at which events occur is used to determine various
3 performance metrics, providing clear support and understanding for this added recitation to Claim 1. In
4 contrast, Burman discloses that "the rich media script may also cause the user's browser to *fetch or*
5 *request other images* so that transfer time and/or the user's bandwidth between the user's computer and
6 other device connected to the computer network 22 may be determined." (Burman, paragraph 81, lines 8-
7 10, emphasis added.) And Burman also teaches that "the rich media may initiate or run one or more
8 nested sequences of one or more steps in the method 110 or initiate *a request for content to be served to*
9 *the user's browser.*" (Emphasis added, paragraph 81, lines 14-17 of Burman.) Furthermore, Burman
10 makes it very clear as evidenced by lines 1-22 of the Abstract of the reference that the purpose of the
11 invention disclosed therein is to calculate the bandwidth between devices on a network in order to select
12 which *additional* content will be served to a user's browser (i.e., so that smaller files will be served if the
13 bandwidth is too limited). Simply stated, the disclosure and teaching of Burman is in direct contravention
14 with applicants' amended Claim 1, which recites not only that performance metrics are determined
15 "*without* using the performance monitoring function to request *any* distributed application data from any
16 site," but also recites that a performance or browser monitoring function is determined "*in connection with*
17 *timing of events occurring during the transmission of the distributed application data to the second site*"
18 (emphasis added), and not based upon the timing determined when downloading other data. Therefore, it
19 is impossible to practice Berman's invention according to the recitation of applicants' Claim 1, and
20 Burman actually teaches away from applicants' Claim 1 by requiring additional steps that are contrary to
21 the recitation in applicants' claim. Therefore, for each of these additional reasons, Claim 1 is patentable
22 over Burman.

23 Each of Claims 13 and 21 have also been amended to recite that a performance or browser
24 monitoring function determines performance metrics **without** using the performance or browser
25 monitoring function "to request any distributed application data from any site" and to recite, "*at least one*
26 *performance metric being determined in connection with timing of events occurring during the*
27 *transmission of the distributed application data to the client device*" (emphasis added). Therefore,
28 Claims 13 and 21 are also novel over Burman for the reasons presented above for patentability of
29 Claim 1.
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1 Claim 35 has been amended to clarify that "*neither the compound performance metric nor the*
2 *correlated performance metric* [are] *determined using the browser monitoring function to request any*
3 *Web page from any site*" (emphasis added). As discussed above, Burman discloses and teaches that "the
4 rich media script may also cause the user's browser to *fetch or request other images* so that transfer time
5 and/or the user's bandwidth between the user's computer and other device connected to the computer
6 network 22 may be determined." (Emphasis added, Burman, paragraph 81, lines 8-10.) Burman does not
7 disclose or suggest any other method to determine "transfer time and/or the user's bandwidth between the
8 user's computer and other device connected to the computer network." Therefore, Burman does not
9 anticipate applicants' Claim 35 or render it obvious, since Burman fails to disclose or suggest what is
10 recited by applicants' Claim 35. Furthermore, Burman explicitly teaches away from applicants' Claim 35,
11 since no alternatives to the requesting an additional download are either explicitly taught or suggested by
12 Burman, and the method of Burman cannot be implemented according to the recitation of Claim 35.

13 Claim 42 has been amended to clarify that the "machine instructions that perform a browser
14 monitoring function" are implemented "**without** using the browser monitoring function to request any
15 *further download* from any site, said at least one performance metric including at least one of compound
16 performance metric and a correlated performance metric" (emphasis added). As discussed above,
17 Burman does not disclose or suggest any method to determine "transfer time and/or the user's bandwidth
18 between the user's computer and other device connected to the computer network," that can be
19 accomplished **without** using the browser monitoring function to request a *further download* from a site.
20 Therefore, Burman does not anticipate applicants' Claim 42, since Burman never discloses that which is
21 recited by applicants' Claim 42. Furthermore, Burman explicitly teaches away from applicants' Claim 42,
22 since the recitation of the claim is not explicitly taught or suggested by Burman, and the method of
23 Burman cannot be implemented according to the recitation of Claim 42.

24 Dependent claims that depend from patentable independent claims are patentable for at least the
25 same reasons that the independent claims are patentable. For this reason, claims dependent on each of
26 Claims 1, 13, 21, 35 and 42 are all patentable for each of the reasons presented above. For each of the
27 above reasons, applicants respectfully submit that claims 1-56 are all patentable over the cited art.

28 Claims Rejected under 35 U.S.C. § 103(a)

29 The Examiner has rejected Claims 4, 6, 11, 16, 18, 23, 24, 26, 33, 34, 36, 44, 45, and 47 under 35
30 U.S.C. § 103(a) as being unpatentable over Burman in view of U.S. Patent No. 6,411,998 (Bryant et al.,

1 hereinafter referred to as "Bryant"). Claims 5, 17, and 25 were rejected under 35 U.S.C. § 103(a) as being
2 unpatentable over Burman in view of Bryant and further in view of U.S. Patent No. 5,732,218 (Bland et
3 al., hereinafter referred to as "Bland"). Claims 8, 27, 28, 37, 48, 49, 54, and 56 were rejected under 35
4 U.S.C. § 103(a) as being unpatentable over Burman in view of Bland. The Examiner rejected Claims 9,
5 20, 30, 39, and 51 under 35 U.S.C. § 103(a) as being unpatentable over Burman in view of a non-patent
6 publication entitled "A Survey of Web Caching Schemes for the Internet," authored by Jia Wang, Cornell
7 Network Research Group, Department of Computer Science, Cornell University, Ithaca, NY (hereinafter
8 referred to as "Wang"). Finally, the Examiner rejected Claim 55 under 35 U.S.C. § 103(a) as being
9 unpatentable over Burman in view of Bland and further in view of Bryant.

10 It is axiomatic that a claim that depends from an allowable claim is also allowable for at least the
11 same reasons. Claims 4, 5, 6, and 11 depend from independent Claim 1, dependent Claims 16, and 18
12 depend from independent Claim 14, dependent Claims 23, 24, 26, 33, and 34 depend from independent
13 Claim 21, and dependent Claims 36, 44, 45, and 47 depend from independent Claim 42. For the reasons
14 stated above, Burman does not teach or suggest the recitation of independent Claims 1, 14, 21, 35, and 42,
15 and Bryant does not provide any teaching or suggestion that would lead one of ordinary skill in the art to
16 achieve applicants' claimed recitation. Accordingly, the rejection of Claims 4, 6, 11, 16, 18, 23, 24, 26,
17 33, 34, 36, 44, 45, and 47 as being obvious over Burman in view of Bryant should be withdrawn.

18 Applicants respectfully submit that the rejection of Claims 5, 17, and 25 is unjustified and should
19 be withdrawn. Claim 5 depends from independent Claim 1, Claim 17 depends from independent
20 Claim 14, and Claim 25 depends from independent Claim 21. For at least the reasons discussed above,
21 Burman does not disclose, teach, or even suggest the recitation of Claims 1, 14, and 21, and neither
22 Bryant nor Bland provide any further teaching that would cure this shortcoming. Therefore, Burman in
23 combination with Bryant cannot be a basis for rejecting Claims 5, 17, and 25, which depend from
24 Claims 14, and 21, under 35 U.S.C. § 103. Accordingly, the rejection of Claims 4, 6, 11, 16, 18, 23, 24,
25 26, 33, 34, 36, 44, 45, and 47 as being obvious over Burman, in view of Bryant, and further in view of
26 Bland should be withdrawn.

27 For similar reasons, the rejection of Claims 8, 27, 28, 37, 48, 49, 54, and 56 is improper and
28 should be withdrawn. Claim 8 depends from independent Claim 1, Claims 27 and 28 depend from
29 independent Claim 21, Claim 37 depends from independent Claim 35, and Claims 48, 49, 54, and 56 all
30 depend from independent Claim 42. For at least the reasons discussed above, Burman does not disclose

1 or suggest the recitation of any of Claims 1, 21, 35, and 42, and Bland fails to provide the required
2 teaching or suggestion that would justify rejection of these independent claims. Accordingly, the
3 rejection of Claims 8, 27, 28, 37, 48, 49, 54, and 56 as being obvious over Burman in view of Bland
4 should be withdrawn.

5 Applicants also respectfully submit that the rejection of Claims 9, 20, 30, 39, and 51 is also
6 unjustified. Claims 9, 20, 30, 39, and 51 depend from independent Claims 1, 21, 35, and 42, respectively.
7 For at least the reasons discussed above, Burman does not teach or suggest the recitation of any of Claims
8 1, 21, 35, and 42, and Wang fails to provide any teaching or suggestion that would justify the rejection of
9 these claims. Therefore, Claims 9, 20, 30, 39, and 51, which respectively depend from Claims 1, 21, 35,
10 and 42, are clearly not obvious over Burman in view of Wang.

11 Finally, the rejection of Claim 55 is unjustified. Claim 55 depends from Claim 42, and for at least
12 the reasons discussed above, Burman, even in combination with Bland, and Bryant, fails to teach or
13 suggest the recitation of Claim 42. Therefore, the combination of Burman, Bland, and Bryant cannot be
14 properly used to reject Claim 55. Accordingly the rejection of Claim 55 as being obvious over Burman in
15 view of Bland, and further view of Bryant should be withdrawn.

16 In view of the preceding remarks, it should be evident that this application is in condition for
17 allowance and should be passed to issue without delay. Should any further questions remain, the
18 Examiner is invited to telephone applicant's attorney at the number listed below.

19 Respectfully submitted,

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24 RMA/PJN:elm

25 MAILING CERTIFICATE

26 I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed
27 envelope as first class mail with postage thereon fully prepaid addressed to: Commissioner for Patents,
28 Alexandria, VA 22313-1450, on January 6, 2006.

29 Date: January 6, 2006

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